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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,119	07/23/2001	Christopher J. Chase	SP01-189	2420

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CORNING INCORPORATED
SP-TI-3-1
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EXAMINER

KIM, AHSHIK

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/911,119

Applicant(s)

CHASE ET AL.

Examiner

Ahshik Kim

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 8-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-3,5,17,21,22,25,26,29,30,32-35 and 39-42 is/are rejected.
- 7) ☒ Claim(s) 8-16,18-20,23,24,27,28,31 and 36-38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed on May 2, 2003. In the amendment,
5 claims 4, 6, and 7 were canceled, and claims 1, 5, and 8 were amended. Accordingly, claims 1-3,
5, and 8-42 remain for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
10 basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
sale in this country, more than one year prior to the date of application for patent in the United States.

- 15 2. Claims 32 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Nielsen
(US 6,151,123).

Nielsen teaches a method and apparatus to obtain characteristics/properties of diverse
arrays of materials (col. 4, lines 38+) including diffusion of molecule and diffusion rates (col. 9,
line 62 – col. 10, line 18). Diffusion can occur horizontally or vertically. Vertical diffusion can
20 be considered as from an upstream area toward a downstream area.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5, 16, 21, 22, 25, 26, 29, 33, 35, and 40-42 are rejected under 35 U.S.C.

103(a) as being unpatentable over Nielsen (US 6,151,123) in view of Ulmer (US 5,776,674).

10 The teachings of Nielsen have been discussed above.

Nielsen fails to specifically teach or fairly suggest that the device is comprised of first and second compartments.

Re claims 1-3, 5, 21, 33, 35, and 40-42, Ulmer teaches a system and the apparatus for observing chemical or biochemical reaction (see abstract) comprising a first compartment 100 in the form of a thin film (or a membrane) and a second compartment – group of sample wells 102 as shown in figure 3B (col. 4, lines 14+). As further disclosed, the first compartment can have a ligand molecule (col. 6, lines 57+) as recited in claim 7. Ulmer's system further comprising refractive index matching capacity (col. 2, lines 28+) as described in claim 16.

In view of Ulmer's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to employ well-known device having separate compartments, which allows interaction between target materials to the teachings of Nilesen in order to observe chemical/biochemical interaction. It is also noted that the reference to Nielsen does not provide a great detail on the structure of the apparatus. Adapting the apparatus disclosed in Ulmer, Nielsen not only observes the characteristics of materials, but also is able to observe and measure the interaction between receptor and a ligand molecule.

Re claim 22, Nielsen further discloses that the material to be observed/interrogated includes polymers (see abstract).

Re claims 25, 26, and 29, when the sample is created, the substrate 102 becomes a substrate on which the light can be applied, reflected, and diffracted. The sample wells can be
5 interpreted as an opening, which generates diffraction pattern.

4. Claims 30 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen (US 6,151,123) as modified by Ulmer (US 5,776,674) as applied to claim 29 above, and further in view of Hirleman, Jr. (US 5,007,737). The teachings of Nielsen as modified by Ulmer have
10 been discussed above.

Nielsen/Ulmer fail to specifically teach or fairly suggest that the optical device used in observing the sample generates Frunhofer diffraction pattern.

Hirleman, Jr. teaches a particle sizing system (see abstract) comprising an optical system (see figure 3) generating Frunhofer diffraction pattern (col. 5, lines 43+).

15 In view of Hirleman, Jr.'s teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to further employ well-known Fraunhofer diffraction effect to the teachings of Nielsen/Ulmer in order to capture additional data-providing information on the sample material. Sine Fruanhofer diffraction pattern is generally a curricular or symmetric in nature, such pattern can be used in calculating how fast or how wide diffusion
20 occurs from the receptor material to ligand (or to buffer solution). It is the Examiner's view that Fraunhofer effect is well known in the art, and widely used in a measurement apparatus including optical system. Accordingly, one of ordinary skill in the art to incorporate such feature

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to collect the data from the sample, although embodiment disclosed in Hirleman, may be in different area than claimed invention in instant application.

Allowable Subject Matter

5 5. Claims 8-16, 18-20, 23, 24, 27, 28, 31, 36-38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter: the
10 claims are directed at a system and the method for detecting diffusion of biomolecules utilizing optical detection component. Such detection system comprising an assay, sample dropping apparatus and applying ligand (or other binding agent) is fairly well known and disclosed in some of the references cited. However, the cited references, taken alone or in combinations, fail to suggest or teach a specific apparatus whose structure includes Y-shaped area including
15 sensing area. The system also detects change in the far field diffraction pattern generated by three laterally spaced openings as set forth in the claims.

Response to Arguments

7. Applicant's arguments and remarks filed on May 2, 2003 have been carefully considered,
20 but they are not persuasive.

In responding to Applicant's argument that the Nielsen patent does not teach the claimed invention (see paragraph 3 on page 3), it is Examiner's view that the Nielsen patent teaches the subject matter now recited in claims 32 and 39. Although overall context or the actual

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embodiment suggested by the Nielson patent may be somewhat different than the claimed invention disclosed in the instant application, it is Examiner's position that the reference teaches the methods recited in claims 32 and 39.

In the amendment, Applicant amended claim 1 by incorporating the elements recited in
5 claims 5 and 6 – a first compartment and a second compartment and boundary area disposed between the first and second compartments. Although the scope of the independent claim 1 is narrower now, a first compartment and a second compartment are suggested by the Ulmer patent (see paragraph 3 above).

In response to applicant's argument that there is no suggestion to combine the references,
10 the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.
15 1992). In the instant case, the primary reference to Nielsen and the secondary references to Ulmer and Hirleman are directed at an apparatus and the methods for observing chemical/biological reactions. Accordingly, a particular feature disclosed in a reference can certainly be used in other similar application/references in that one ordinary skill in the art would reasonably be motivated to incorporate such feature for obtaining the improvement/benefit of
20 such feature.

The amended claims and remarks describing these elements have been fully considered, but they are not persuasive, and therefore, the Examiner has made this Office Action final.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

5 policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period
10 will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the
15 examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the
20 Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

25 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

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Ahshik Kim
Patent Examiner
Art Unit 2876
July 8, 2003

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